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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/535,723	05/20/2005	Manuel Vangelisti	P/3610-59	9221
2352 7590 07/11/2007 OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403			EXAMINER ROBINSON, BINTA M	
			ART UNIT 1625	PAPER NUMBER
			MAIL DATE 07/11/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/535,723	Applicant(s) VANGELISTI, MANUEL	
	Examiner Binta M. Robinson	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-8 and 11-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 2-8 and 11-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: <u>5/25/06</u> <u>5/20/05</u> | 6) <input type="checkbox"/> Other: ____ |

Detailed Action

The 112, second paragraph rejection of claims 11-12 has been withdrawn in light of applicant's amendments and remarks filed 5/23/07. The 103 (a) rejection over Dann et. al. in view of Rylander or Frebault is withdrawn over claims 9-10 in view of applicant's amendments filed 5/23/07.

(modified rejection)

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-8, 11- 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dann et. al. (See Reference O) in view of Rylander or Frebault . (Hcaplus 1906:119496).

Dann et. al. (WO0216322) teaches the process of preparing aminomethylpyridines of the compound of formula I which is performed at 0 to 60 degrees Celsius using a Palladium catalyst. At claim 12, page 13, see the Dann process. The difference between the prior art process and the instantly claimed process is the teaching of the process of preparing aminomethylpyridines of the compound of formula I using a nickel catalyst which is performed at a temperature from 0 to 60 degrees Celsius versus the instant process of preparing aminomethylpyridines which occurs at the range of the Temperature of from

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30 to 70 degrees Celsius, under a hydrogen pressure of from 10 to 20 bar which the instant process occurs at- the instant process also uses a Raney Nickel catalyst rather than a Nickel one. Rylander teaches that Nickel is one of the best catalysts for converting low molecular weight aliphatic nitriles to primary amines. See page 140 of Rylander. Frebault states that that corresponding hydrocarbons were obtained from the hydrogenation of aromatic nitriles in the presence of reduced nickel at 200 degrees, and that the reaction is similar to that which takes place with the aliphatic nitriles. It would have been obvious to one of ordinary skill in the art to perform this process of preparing aminomethylpyridines of the compound of formula I which is performed at temperature from 30 to 70 degrees Celsius and under a hydrogen pressure of from 10 to 20 bar, which is a range which overlaps with that of the prior art Temperature range at which the prior art process occurs, using a Raney Nickel Catalyst. One of ordinary skill in the art would have recognized the suitability of adjusting the prior art ranges to reach the claimed ranges. See *In re Harris*.

Accordingly, the instant process is deemed unpatentable therefrom in the absence of a showing of unexpected results for the claimed process over those of the prior art process.

Response to Applicant's Remarks

The applicant traverses the 103 rejection over Dann in view of Rylander or Frebault, alleging that Raney nickel is not cited, and that furthermore, the use of acetic acid to perform the catalytic hydrogenation is not disclosed in Dann et. al. reference. However, Dann et. al. does disclose the use of nickel and teaches the use of various

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solvents, including alcohols, esters, and ethers, in the presence of a mineral acid. See paragraphs 16 and 17. The fact that palladium is the preferred embodiment does not really matter, since nickel is clearly taught. The applicant does not teach that the pressure limitations, solvent differences, and different form of nickel of claims 13 and 14 are nonobvious over Dan in view of Rylander or Frebault in terms of the results of the reaction. The applicant's reaction results have not been shown to be nonobvious over the art.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binta M. Robinson whose telephone number is (571) 272-0692. The examiner can normally be reached on M-F (9:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Janet Andres can be reached on 571-272-0867.

A facsimile center has been established. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine are (703)308-4242, (703)305-3592, and (703)305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)-272-1600.

Binta Robinson

BMR
July 6, 2007

Janet L. Andres
JANET L. ANDRES
SUPERVISORY PATENT EXAMINER